

REMARKS

This paper is being presented in response to the non-final official action dated December 1, 2006, wherein: (a) claims 1-10, 14, 15, 17-26, 30, 31, 33-36, 45-52, 55, and 56 were pending; (b) claims 1-9, 14, 15, 17-25, 30, 31, 33, 49-52, 55, and 56 were rejected under 35 USC § 103(a) as obvious over Ginter et al. U.S. Patent No. 5,892,900 ("Ginter") in view of Popolo et al. U.S. Patent No. 5,715,402 ("Popolo"); and, (c) claims 10, 18, 26, 34-36, and 45-48 were rejected under 35 USC § 103(a) as obvious over Ginter in view of Popolo, further in view of Silverman et al. U.S. Patent No. 5,924,083 ("Silverman"). Reconsideration and withdrawal of the rejections are respectfully requested in view of the following remarks.

This paper is timely filed as it is accompanied by a petition under 37 CFR § 1.136(a) for an extension of time to file in the third month, and payment of the required extension fee.

I. The 35 USC § 103(a) Rejection Is Traversed

All pending claims were rejected as obvious over either the combination of Ginter and Popolo or Ginter, Popolo, and Silverman. See pp. 3-18 of the action. Reconsideration is requested.

A. Proper Basis for a § 103(a) Rejection

A claim is obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 USC § 103(a).

A conclusion of obviousness based on the combination of known elements requires a reason to combine the elements in the fashion claimed:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an *apparent reason to combine the known elements in the fashion claimed* by the patent at issue. To facilitate review, this analysis should be made explicit.

KSR Int'l Co. v. Teleflex, Inc., 550 U.S. ___, Case No. 04-1350, slip op. at 14 (U.S. Apr. 30, 2007) (emphasis added). Thus, "rejections on obviousness grounds *cannot be sustained by mere conclusory statements*; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added); see also *KSR*, slip op. at 14 (citing *In re Kahn*).

B. Disclosures of Ginter, Popolo, and Silverman

Ginter discloses methods and systems for secure transaction management and electronic rights protection. The methods are generally directed to electronic security. More specifically, a virtual distribution environment (VDE) is disclosed that controls, meters, and/or monitors the use of electronically stored or disseminated information. See, e.g., Ginter at abstract.

Popolo discloses a method and a system for matching sellers and buyers of spot metals such as steel. The disclosed method is particularly directed toward the secondary steel market. In the disclosed method, sellers post metal item lots for sale and buyers are able to search and bid on posted items. See, e.g., Popolo at abstract.

Silverman discloses a distributed electronic trading system. The system includes a market view display of bids and offers for trading instruments based on unilateral or bilateral credit availability. See, e.g., Silverman, col. 1, lines 6-11.

C. The Official Action Provides No Rationale Supporting Its Conclusion of Obviousness

All pending independent claims are directed to the exchange of metals: claims 1, 19, and 34 recite methods of exchanging metals, and claim 49 recites a metals exchange server.

Among the cited references, only Popolo relates to metals, while Ginter and Silverman are completely silent with respect to metals trading. Accordingly, the applicants submit that there is no reason that the skilled artisan would have combined the elements of Ginter and Popolo or Ginter, Popolo, and Silverman to obtain the subject matter recited in independent claims 1, 19, 34, and 49.

Moreover, the action provides no rationale supporting its conclusion of obviousness. Instead, the action only makes the conclusory statement that it would have been obvious to combine elements of the cited references to obtain the recited subject matter. For example, in relation to claims 1, 19, and 49, the action simply states:

It would be obvious to one or ordinary skill in the art to combine the teachings of Ginter and Popolo in order to obtain a method of exchanging metals which take[s] into account the specific characteristics of various metals as well as protocols for secure transactions.

See pp. 4, 8, and 12 of the action (claims 1, 19, and 49, respectively). Similarly, in relation to claim 34, the action simply states:

It would be obvious to one or ordinary skill in the art to combine the teachings of Ginter, Silverman, and Popolo in order to obtain a method of exchanging metals which take[s] into account the specific characteristics of various metals as well as protocols for secure transactions.

See p. 16 of the action.

The action's foregoing conclusory statements fail to provide an articulated reasoning with a rational underpinning to support the legal conclusion of obviousness; thus, they are insufficient to support the present obviousness rejections. See *In re Kahn*, 441 F.3d at 988; KSR, slip op. at 14. Accordingly, the applicants request the withdrawal of the obviousness rejections for pending claims 1-10, 14, 15, 17-26, 30, 31, 33-36, 45-52, 55, and 56.

CONCLUSION

In view of the foregoing, reconsideration and withdrawal of the rejections and allowance of all pending claims 1-10, 14, 15, 17-26, 30, 31, 33-36, 45-52, 55, and 56 are respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, the examiner is urged to contact the undersigned attorney.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

May 31, 2007


Roger A. Heppermann (Reg. No. 37,641)
Attorneys for Applicants
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
Telephone: (312) 474-6300